

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID W. MARUSKA and JONATHAN C. CROWELL

Appeal No. 1998-0714
Application No. 08/092,622

ON BRIEF

Before BARRETT, DIXON, and GROSS, Administrative Patent Judges.
GROSS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 16, which are all of the claims pending in this application.

Appellants' invention relates to a clustered computer system. Specifically, the system includes at least two central processing units and a single power source in a cabinet, with one central processing unit enclosed in a housing that can be physically mounted in a disk drive slot of

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the cabinet. Claim 1 is illustrative of the claimed invention, and it reads as follows:

1. A general purpose computer apparatus comprising:

a central processing unit;

a main memory;

a system bus;

first means for interfacing said central processing unit to said system bus;

second means, coupled to said system bus, for interfacing said central processing unit to an I/O bus; and

a housing enclosing said central processing unit, said main memory, said system bus and said first and second means for interfacing, said housing having a size and shape so that the housing can be physically mounted in a disk drive slot of a computer system.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Blackborow et al. (Blackborow)	5,253,129	Oct. 12, 1993
		(filed Nov. 12, 1991)
Kobayashi	5,463,742	Oct. 31, 1995
		(filed Mar. 05, 1993)

Claims 1 through 16 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kobayashi in view of Blackborow.

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Reference is made to the Examiner's Answer (Paper No. 16, mailed April 15, 1997) for the examiner's complete reasoning in support of the rejections, and to appellants' Brief (Paper No. 15, filed January 13, 1997) and Reply Brief (Paper No. 17, filed June 16, 1997) for appellants' arguments thereagainst.

OPINION

As a preliminary matter, we note that appellants indicate on page 7 of the Brief that the claims are not to stand or fall together. Appellants propose the following four groups of claims and argue each group separately in accordance with 37 C.F.R.

§ 1.192(c)(7): 1) claims 1 and 2, 2) claims 3 through 8, 3) claims 9 through 15, and 4) claim 16. As we agree with the proposed grouping, we will treat the claims accordingly, with claims 1, 3, 9, and 16, respectively, as representative.

We have carefully considered the claims, the applied prior art references, and the respective positions articulated by appellants and the examiner. As a consequence of our review, we will affirm the obviousness rejection of claims 1 and 2 and reverse the obviousness rejection of claims 3 through 16.

Regarding representative claim 1, the examiner states (Answer, page 4) that Blackborow teaches "a system in which a subsystem that includes a CPU, memory, bus, and means for interfacing is enclosed by a housing that can occupy a disk drive well of a computer system."¹ The examiner asserts (Answer, pages 4-5) that it would have been obvious to "incorporate the teaching of Blackborow into Kobayashi because Kobayashi's PPM (personal processor module) is intended to be the size of a hard disc drive and a microprocessor (col. 5, lines 43-47). That suggests that the housing of Kobayashi be mounted in a disk drive slot."

Appellants contend that there is no suggestion or motivation to connect the PPM to a disk drive slot of an existing computer system, as to do so would be contrary to Kobayashi's invention. We agree. The purpose of Kobayashi's system is to allow a user to connect to different docking stations for working in different locations, but still

¹ We note that Blackborow alone appears to include all of the elements of a computer, i.e., a CPU, memory, system bus, and I/O interface means, enclosed in a housing sized and shaped to fit in a disk drive slot of a computer, as recited in at least claim 1. See, for example, Figure 7A. However, we decline to make a new ground of rejection; we leave it to the examiner to do the fact-finding to determine if such a rejection would apply.

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maintain the consistency of the personal configurations of the user. In fact, Kobayashi specifically precludes including the PPM in another computer system, as Kobayashi states (column 5, lines 56-63) that the docking stations

would have the physical appearance of a notebook or desktop computer, but as shown in FIG. 2, the docking station would not include the processor or the application software or operating system which are usually a part of any computer. These would be carried in and supplied by the PPM so that every docking station would present the same interface to the PPM user. (Underlining ours for emphasis)

The Federal Circuit has held that "a proposed modification [is] inappropriate for an obviousness inquiry when the modification render[s] the prior art reference inoperable for its intended purpose. *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)." *In re Fritch*, 972 F.2d 1260, 1265-1266 n.12, 23 USPQ2d 1780, 1783 n.12 (Fed. Cir. 1992). As the combination proposed by the examiner of Kobayashi and Blackborow would defeat the purpose of Kobayashi's system, the examiner has failed to establish a *prima facie* case of obviousness by combining the two references.

However, the first step of an obviousness analysis under 35 U.S.C. § 103 is to determine the scope of the claims. *In re Hiniker Co.*, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Claim 1 recites a computer including a central processing unit, a main memory, a system bus, and first and second interfacing means, all of which are included in Kobayashi's PPM. Claim 1 further requires that the above elements be enclosed in a housing "having a size and shape so that the housing can be physically mounted in a disk drive slot of a computer system." Claim 1 does not require that the enclosure actually be mounted in a computer system, but rather merely requires that the enclosure be sized to fit in a disk drive slot.

Appellants argue (Brief, page 9) that the portion of Kobayashi relied upon by the examiner does not suggest that the housing be mounted in a disk drive slot. Appellants point out (Brief, pages 9-10) that Kobayashi discloses (column 3, lines 40-42 and 60-65) that the PPM is to be as small as possible while still providing the minimum components needed for personal processing capability, and that the size will be

reduced each year as the cost and technology change. Nonetheless, Kobayashi discloses (column 7, lines 59-63) that the central elements of the PPM could be incorporated in a module that is 9.06" long, 5.12" wide, and 0.91" high, which is sized and shaped so that the housing could be physically mounted in a disk drive slot. Thus, Kobayashi meets all of the limitations of claim 1 with Blackborow being merely cumulative. Although the rejection is based on Kobayashi in view of Blackborow, it is permissible to affirm the rejection relying on only Kobayashi. See *In re Bush*, 296 F.2d 491, 496, 131 USPQ 263, 266-67 (CCPA 1961). Accordingly, we will affirm the rejection of claim 1 and of claim 2, grouped therewith.

As to the second group of claims, representative claim 3 requires that the second means for interfacing "allows communications from one central processing unit to a second central processing unit." As stated above, Kobayashi includes a single central processing unit and precludes adding a second central processing unit. Therefore, the combination fails to meet the claim limitation. Accordingly, we cannot sustain the rejection of claim 3 nor of the claims grouped therewith, claims 4 through 8.

Claim 9, the representative for the third group of claims, clearly recites two central processing units in which the second is enclosed in a housing that can be mounted in a slot for receiving a disk drive. As indicated above, the references teach away from including a second central processing unit. Kobayashi also suggests that the PPM should be as small as possible, and should not be limited to the size of a disk drive slot. Thus, no *prima facie* case of obviousness has been established. Therefore, we cannot sustain the rejection of claims 9 through 15.

Regarding claim 16, the claim recites a cabinet for housing a computer system and two general purpose computers, each with a central processing unit, wherein the second general purpose computer is disposed in a disk drive opening in a panel of the cabinet. As previously determined, the combination of Kobayashi and Blackborow does not teach or suggest two central processing units. Further, neither reference suggests providing the second central processing unit in a disk drive opening in a panel of a computer system cabinet. Consequently, as no *prima facie* case of obviousness

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has been established, we cannot sustain the rejection of claim
16.

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CONCLUSION

The decision of the examiner rejecting claims 1 through 16 under 35 U.S.C. § 103 is affirmed as to claims 1 and 2 and reversed as to claims 3 through 16.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED-IN-PART

LEE E. BARRETT)	
Administrative Patent Judge)	
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JOSEPH L. DIXON)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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ANITA PELLMAN GROSS)	
Administrative Patent Judge)	

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